IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of			Date: May 2, 2007
Isaak Volynsky			Docket No.: MAT 3H2
Serial No.	:	10/663,039	Examiner: Alyssa M. Hylinski
Filed	:	September 15, 2003	Group Art Unit: 3711
For	:	HIGH-VOLUME INSERTS FOR FLEXIBLE DOLLS	

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR RECONSIDERATION

These remarks are responsive to the Office action mailed February 12, 2007. Claims 1-38 are pending in the application. Claims 1-23 and 25-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Atwood (U.S. Patent No. 186,919), Piotrovsky (U.S. Patent No. 4,470,784), and Miura et al. (U.S. Patent No. 5,989,658). Claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Atwood, Piotrovsky, Miura et al., and Hanf (U.S. Patent No. 3,609,911). Applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

Atwood appears to disclose a process for forming a seamless metal doll B over a mold A as shown in Fig. 1, such as by suspending the mold in a bath during an electroplating process. The mold material, such as wax or rubber, may then be melted out of the metal doll to be reused. The body segments are created separately and may be coated with wax, paint, or rubber (column 1, line 11 – column 2, line 15).

Piotrovsky appears to disclose collapsible pin assemblies 56 used to maintain inserts in a fixed position during insert molding while preventing surface blemishes. The pins 64 collapse into bosses 58, away from the mold, due to the pressure of the molding material as the mold is filled to capacity, as shown in Fig. 6 (column 2, lines 63-68). The bosses are integrally formed with the insert 30, such as lower member 42, when the insert is molded from a suitable polymer, as shown in Fig. 4 (column 2, lines 32-35).

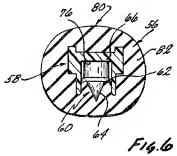


Fig. 6

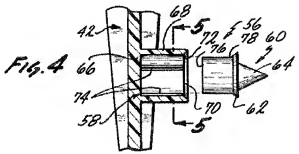


Fig. 4

Miura et al. appears to disclose a joint assembly which is capable of a click motion to maintain a user-defined position and a process for manufacturing such a joint, as shown below in

Figs. 26 and 29 (column 1, line 63 - column 2, line 13). Several materials are used which differ by melting point so as not to weld the joint components in a fixed position during the four-step molding process.

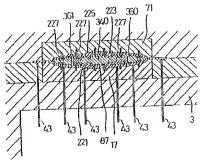
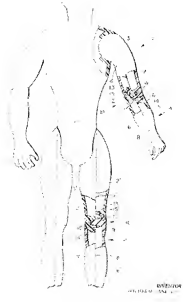


FIG. 26

FIG. 29

Hanf appears to disclose a flexible limb for a doll, as shown below in Fig. 1. The limb includes an elbow joint having a centering piece 11 and a conical lug 12 that fits into the centering piece (column 2, lines39-44). The joint components are formed in arm halves 2, 3, 5, 6 to reduce production costs (column 1, line 58 – column 2, line 3).



Applicant believes it is important to reiterate the Examiner's burden in establishing a *prima facie* case of obviousness because there simply is no reason to make the proposed

combination except to reconstruct the subject matter recited in the pending claims. Furthermore, doing so teaches away from the disclosure of the cited references and requires additional structure that would not be required but for the proposed combination. In applying 35 U.S.C. § 103, the references must suggest the desirability, and thus, the obviousness of making the combination. As stated by the Federal Circuit in *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992):

> [T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. 'The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' ... Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the invention.'

Id. at 1265-1266 (citations omitted). Moreover, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136 (Fed. Cir. 1986).

Hindsight reconstruction is evidenced by defining the problem in terms of its solution. *Monarch Knitting Machinery Corp. v. Sulzer Morat* GmbH, 139 F.3d 877, 882 (Fed. Cir. 1998). In each of the obviousness rejections set forth in the Office action, the rejections are predicated upon solving the problem of "speed[ing] up the manufacturing process" (Office action, page 2). Applicants submit that this approach is exactly what the cited case law cautions against, as the problem has been defined based upon the solution recited in independent claims 1, 16, 25, and 31. Accordingly, the rejections are not properly supported and should be withdrawn. More specifically, the problem expressed in the Office action, namely, speeding up the manufacturing process, has been defined in terms of the solution presented in the pending claims. Namely, a toy figure including a hollow body portion and at least one engagement portion for engaging

another body portion, or a portion of an inner skeleton, as recited in claims 1, 25, and 31; and a substantially hollow body of an insert including a plurality of stabilization pegs and at least one engagement portion, as recited in claim 16. Applicants submit that the claimed portions are but one of many possible solutions to the problem of manufacturing process speed. Thus, by defining the problem in terms of its solution, the Examiner has presumed the solution to the problem. Furthermore, this ignores the lack of any suggestion or motivation in the prior art to make the proposed combination of the prior art references. *See Id.*

Applicant notes that there is no teaching or motivation, other than applicant's disclosure, to combine the forming process of Atwood with the collapsible pin assemblies of Piotrovsky. Perhaps more specifically, the insert forming process of Atwood is limited to electroplating a seamless metal coating over an interior mold. In contrast, Piotrovsky uses insert molding to form the bosses on the exterior surface, which is accomplished with the use of a mold on the exterior of the article to be formed, rather than the interior. There is no teaching or suggestion in either reference that would lead to forming a boss on the outer surface of the doll formed according to Atwood, or of how to form a hollow region in the interior of the insert of Piotrovsky (or Miura et al.).

Furthermore, the proposed combination of Atwood, Piotrovsky, and Miura et al. defeats Atwood's purpose of producing a cheap seamless metal doll since the proposed combination requires additional steps and components, rather than fewer. Additionally, without the pressure provided by an external mold, the pins of Piotrovsky would not shift inward into the bosses, thus rendering the pins, and therefore the teachings of Piotrovsky, no longer functional.

Moreover, the metal doll of Atwood is only hollow if the interior mold material is melted out. Therefore, the metal doll of Atwood necessarily has a hole, through which a covering

material would leak into the doll if the doll were subjected to the insert molding processes of Piotrovsky or Miura et al. There is no teaching or motivation in any of the references to account for properly preparing the doll of Atwood for a process such as injection molding.

Additionally, the toy figure of Miura et al. consists of several solid layers of injection molded material and provides even less of a motivation to make the proposed combination since Miura et al. already discloses a manufacturing process in which multiple parts may be formed at the same time.

Applicants submit that there simply is no reason, much less the required teaching or motivation, to make the proposed combination other than to reconstruct the subject matter recited in the pending claims. For at least the above reasons, Applicant requests that the rejection of independent claims 1, 16, 25, and 31 be withdrawn. Claims 2-6, 8-9, and 13-15 depend from and further limit claim 1 and should therefore be allowed when claim 1 is allowed. Claims 17-24 depend from and further limit claim 16 and should therefore be allowed when claim 16 is allowed. Claims 26-30 depend from and further limit claim 25 and should therefore be allowed when claim 25 is allowed. Claims 32-38 depend from and further limit claim 31 and should therefore be allowed when claim 31 is allowed.

With respect to dependent claim 24, there is no teaching or motivation, other than applicant's disclosure, to combine the forming process of Atwood, the collapsible pin assemblies of Piotrovsky, and the insert molding process of Miura et al., as noted above. The addition of the flexible limb of Hanf does not provide the necessary motivation to form such a combination. For at least this reason, applicant requests that the rejection of dependent claim 24 be withdrawn.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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Merissa R. Thompson